

Application No.: 09/960162

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REMARKS

Claims 1 - 86 are pending in this application. Claims 4, 15, 19, 21, 22, 25 - 28, and 39 have been objected to because of informalities in the claims. Claims 4, 15, 19, 21, 22, 25 - 28, and 39 have been amended to correct the informalities. During the review of the application, other grammatical and typographical errors were found in the specification and claims, and these have been corrected by amendment. Other substantive changes have been made to better define the invention. For example, "Display" in the eighth line of claim 1 has been changed to "Transmit", "photographer" has been replaced by "photographer processing unit" and "fulfillment center" by "fulfillment center processing unit" in many places, and "at least one" has been removed before "fulfillment center" everywhere it appeared to exclude the situation where there is just one fulfillment center. With these and other changes, the claims more succinctly and directly claim the invention. These substantive changes may overcome all or most of the rejections of the Examiner. However, we will summarize the differences between the invention as now claimed and the disclosures of the references, and then respond to the individual rejections based on the amended claims to clarify why the amended claims are patentable.

The invention relates to a system involving three different processing units: a first (gateway) processing unit, a photographer processing unit, and a fulfillment center processing unit. Since these are separately recited in the claims, the patent law requires that they be interpreted as separate processing units. Further, under the patent law, the identity of a processing unit cannot shift as a claim is read or between an independent claim and the claims dependent on it. The system according to the invention has the decided advantage of obtaining appropriate customers for fulfillment processing centers and performing the order processing and fiscal accounting functions, thereby freeing the fulfillment centers to do fulfillment. To this end, claim 1 recites a system that includes instructions for the *gateway or first processing unit* to:

Maintain a list of a plurality of fulfillment centers available to generate a photograph from the digital image,

Receive a request from a photographer processing unit for a list of options to generate the photographic product from the digital image,

Transmit to the photographer processing unit the list of options for generating the photographic product,

Receiving an order from the photographer processing unit, and

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Transmitting routing information to the photographer processing unit wherein the routing information is for transmitting the digital image to a fulfillment center processing unit of one of the fulfillment centers to process the order.

Claim 44 is a method claim that includes the same limitations in method form. Note that since some of the functions done by the gateway processor, such as the fiscal functions, need to be done in any photographic fulfillment milieu, these functions may be mentioned in one or more of the cited references. However, it is not just performing the functions that is claimed and which define the invention, but also where the functions are done. This makes the difference between software or a process that does not have commercial usefulness, and something that has been incredibly successful. Putting this in technical patent law terms, none of the references cited by the Examiner has a processing unit that does all of the above-specified and claimed functions.

None of the references cited by the Examiner suggest or disclose a system with a focus of finding customers for the fulfillment center and freeing the fulfillment center of order and fiscal accounting functions, and as a result none include the above limitations. Specifically, US Patent Publication US2001/0049640 (Kurokawa et al.) is designed to allow a conventional film development center to take orders over the Internet. To this end, Kurokawa et al. puts all the order information on a CD-R produced by the fulfillment center, and the photographer processor pulls the order information up from the CD-R. See paragraphs 21 and 22. Note that connection to the Internet is not made until after the order is formulated. See paragraph 26. US Patent No. 6,017,157 (Garfinkle et al.) is designed to retain control of all portions of the traditional fulfillment process in the domain of the fulfillment center. See column 8, lines 38 - 67. To this end, Garfinkle et al. puts all of the digital images on an image server. See column 2, line 62 through column 4, line 20. The photographer can use the image server to manipulate the images and to order prints. See column 7, lines 4 - 52. However, in line with the intention to maintain traditional control of the fulfillment, the photographer can only order prints from the fulfillment center that has control of the images. See column 8, line 38 through column 9, line 25. US Patent No. 6,760,128 (Jackson et al.) is an Eastman Kodak Company patent which discloses a system in which all functions, including storing images, accounting, and fulfillment is done on a single server, which probably is envisioned as being at Kodak. See FIG. 1B and column 4, line 14 through column 5, line 13. US Patent No. 6,404,884 (Marwell et al.) is really non-analogous art, since it has no relation to image processing. It discloses a system in which a user may use the Internet to store a list of telephone numbers on a corporate

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server, which it appears the Examiner considers as the fulfillment center processing unit. The user may call the center to make a phone call to one of the user's numbers. See the Abstract. US Patent No. 6,105,007 (Norris) is even further afield. It discloses a system to permit a customer to perform almost all banking functions at a kiosk remote from the bank. Everything is performed at one processing unit. See the Abstract. As we will see in more detail below in the responses to the individual rejections, since none of the cited references teaches, discloses, suggests or even contemplates the issues addressed by the invention, many of the limitations in the claims, including at least one limitation in claims 1 and 44 (Transmitting to the photographer processing unit routing information for transmitting the digital image to the processing unit of one of the fulfillment centers on the list in the gateway processing unit), are not done by *any* processing unit in *any* of the references.

Claims 1 - 6, 15 - 32, 34 - 40, 43 - 49, 58 - 75, 77 - 83, and 86 have been rejected under 35 USC 103(a) as being unpatentable over Kurokawa et al. (US Patent Application Publication No. 2001/0049640) and Garfinkle et al. (US Patent No. 6,017,157). This rejection is respectfully traversed. Claims 1 and 44 include the limitations: Receive a request from a photographer processing unit for a list of options to generate the photographic product from the digital image; and Transmit routing information to the photographer processing unit wherein the routing information is for transmitting the digital image to a fulfillment center processing unit of one of the fulfillment centers to process the order. None of the processing units in Kurokawa et al. or Garfinkle et al. do any of these functions.

The Examiner states that Kurokawa et al. includes instructions for directing a first (gateway) processing unit to receive a request from a photographer processing unit for a list of options to generate the photographic product from the digital image at page 2, paragraph 23. Claims 1 and 44 have been amended to more clearly indicate that the request comes from the photographer processing unit and goes to the first processing unit. The Examiner may agree that this amendment over comes the rejection. If not, we point out that this is not the case with Kurokawa, since at page 2, paragraph 23, it states that the photographer processing unit receives input from the user, i.e., the photographer, using an input device, which is entirely different than the amended claim language.

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The Examiner states that Kurokawa et al., at page 2, paragraph 27, includes instructions for directing a first processing unit to transmit routing information to the photographer processing unit wherein the routing information is for transmitting the digital image to a fulfillment center processing unit of one of the fulfillment centers to process the order. However, the routing information referred to in this paragraph is to a substitute fulfillment center, not one of the fulfillment centers maintained in the list referred to in the first limitation in claim 1, but a preset fulfillment center determined by the fulfillment processor.

Since at least one limitation in claims 1 and 44 is not shown in either of the cited references or their combination, claims 1 and 44 cannot be obvious under 35 USC 103(a). To establish a prima facie case of obviousness, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991). MPEP 2142 and MPEP 2143 - 2143.03.

Claims 2 - 6, 15 - 32, 34 - 40, and 43 depend on claim 1 and contain all its limitations, and claims 49, 58 - 75, 77 - 83, and 86 depend on claims 44 and contain all its limitations. Thus, these claims are patentable at least because they depend on patentable claim. *In re Fire*, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988) at headnote 4. In addition, many of these claims are independently patentable because their limitations are not shown in either of the cited references. For example, the Examiner states that the limitation of claims 4 and 47 is disclosed in Kurokawa et al. at step 49 of FIG. 2 and page 2, paragraph 30. However, these claims recite that the first (gateway) processing unit receives a confirmation from the photographer processing unit responsive to the digital image being transmitted to the fulfillment center processing unit. In Kurokawa et al., the confirmation is sent by the fulfillment center processing unit, not the photographer processing unit. This is entirely different and serves a different purpose than the claimed limitation. Likewise, the cited passage in Kurokawa et al. that is alleged to disclose the limitations of claims 5 and 48 shows that the substitute fulfillment center is determined by parameters in the server, not in the order, and the passage in Kurokawa et al. that is alleged to disclose the limitations of claims 6 and 49 that is purported to show the reception by a gateway processor of a confirmation from the fulfillment center processing unit that an order has been processed, is instead a confirmation by a photographer processing unit that it will accept the terms of an order. Similarly, with respect to claims 16 and 69, the claims recite communications between the photographer processing unit and the first processing unit, whereas the cited passages of Kurokawa et al. disclose communications between the

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photographer processing unit and the fulfillment center processing unit. Since the Examiner has already designated the gateway processing unit as the first processing unit in his analysis of claim 1, under the patent law he must maintain this designation in dependent claims. This is also true for claims 17 and 60, 18 and 61, and 19 and 62. With respect to claims 21 and 64, the Examiner's argument actually shows that the claims are patentable, because a "handshake" recited by the Examiner is between the two processing units that perform the transmission, but in claims 21 and 64 the transmission in claims 20 and 63 is between the photographer processing unit and the fulfillment center processing unit, while the confirmation ("handshake") is with the first (gateway) processing unit. Again, with respect to claims 22 and 65, the transmission in Kurokawa et al. is between the photographer processing unit and the fulfillment center processing unit, while the claimed communication is with the first (gateway) processing unit. With respect to claims 24 and 67, the fulfillment center is selected by the photographer by clicking on a list provided by the first processing unit, wherein in the claims, the photographer processing unit sends information to the first processing unit which then puts together a list based on the information. With respect to claims 25 and 68, 26 and 69, 27 and 70, and 28 and 71, the combination of Kurokawa et al. and Garfinkle et al. made by the Examiner has a result quite the opposite of what is claimed. If you combine Kurokawa et al. and Garfinkle et al., you get a system where each image has associated with it a specific price sheet with a specific fulfillment center. Thus, once the photographer selects the image of which he wants a print, the fulfillment center is determined, and thus all the other parameters recited in the claims are irrelevant. See Garfinkle et al., column 8, lines 20 - 67. This is in line with the fact that the whole thrust of Garfinkle et al. is to maintain control of the process by the fulfillment center, which is antithetical to the purpose of the present invention. Thus, to get from the combination of Kurokawa et al. and Garfinkle et al. to the present claims, it is necessary to modify the combination using the present claims as a reference. This is not permitted under the patent law. MPEP §2142. See also *In re Vack*, 20 USPQ2d 1438, 1432 (Fed. Cir. 1991), which the MPEP cites in support of this law. See also *W.L. Gore & Associates, Inc. v Garlock*, 220 U.S.P.Q. 303, 311-13 (Fed. Cir. 1983).

Claims 7, 33, 41, 42, 50, 76, 84, and 85 have been rejected under 35 USC 103(a) as being unpatentable over Kurokawa et al. (US Patent Application Publication No. 2001/0049640) and Garfinkle et al. (US Patent No. 6,017,157), as applied to claims 1 and 44 above, and further in view of Jackson et al. (US Patent No. 6,760,128). This rejection is respectfully traversed.

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First of all, claims 7, 33, 41, and 42 depend on claim 1 and claims 50, 76, 84, and 85 depend on claim 44 and include all the limitations of the parent claim, and therefore are patentable because they depend on a patentable claim. Secondly, if Kurokawa et al., Garfinkle et al., and Jackson et al. are combined, what results is a system in which the fulfillment center processor performs all the claimed functions, whereas the claims say that the first (gateway) processor does the functions. Thus, after the combination is made, it is necessary to further modify the combination using the present claims as a guide. This is not permitted under the patent law. MPEP §2142. See also *In re Vaack*, 20 USPQ2d 1438, 1432 (Fed. Cir. 1991), which the MPEP cites in support of this law. See also *W.L. Gore & Associates, Inc. v Garlock*, 220 U.S.P.Q. 303, 311-13 (Fed. Cir. 1983).

Claims 8 - 11 and 51 - 54 have been rejected under 35 USC 103(a) as being unpatentable over Kurokawa et al. (US Patent Application Publication No. 2001/0049640), Garfinkle et al. (US Patent No. 6,017,157), and Jackson et al. (US Patent No. 6,760,128), as applied to claims 7 and 50 above, and further in view of Norris (US Patent No. 6,105,007). This rejection is respectfully traversed.

First of all, claims 8 - 11 depend on claim 1 and claims 51 - 54 depend on claim 44 and include all the limitations of the parent claim, and therefore are patentable because they depend on a patentable claim. Second, it is not believable that someone skilled in the art would look at the four references cited and come up with the claimed invention. In fact, it is highly unlikely that someone skilled in the art of photography fulfillment would have the Norris reference at all, since it is in a completely different field. In technical terms, it is non-analogous art. Third, if the four references are combined, what results is a system where a fulfillment center processor performs the functions claimed in these claims, whereas the claims say that the first (gateway) processor does the functions. Thus, after the combination is made, it is necessary to further modify the combination using the present claims as a guide. This is not permitted under the patent law. MPEP §2142. See also *In re Vaack*, 20 USPQ2d 1438, 1432 (Fed. Cir. 1991), which the MPEP cites in support of this law. See also *W.L. Gore & Associates, Inc. v Garlock*, 220 U.S.P.Q. 303, 311-13 (Fed. Cir. 1983).

Claims 12 - 14 and 55 - 57 have been rejected under 35 USC 103(a) as being unpatentable over Kurokawa et al. (US Patent Application Publication No. 2001/0049640) and Garfinkle et al. (US Patent No. 6,017,157), as applied to claims 1 and 44 above, and further in view of Marwell et al. (US Patent No. 6,404,884). This rejection is respectfully traversed.

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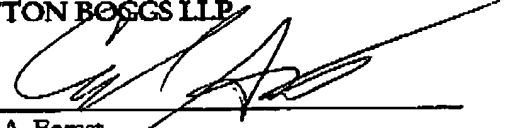
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First of all, claims 12 - 14 depend on claim 1 and claims 55 - 57 depend on claim 44 and include all the limitations of the parent claim, and therefore are patentable because they depend on a patentable claim. Second, it is not believable that someone skilled in the art would look at the four references cited and come up with the claimed invention. In fact, it is highly unlikely that someone skilled in the art of photography fulfillment would have the Marwell et al. reference at all, since it is in a completely different field. In technical terms, it is non-analogous art. Third, if the four references are combined, what results is a system where a fulfillment center processor performs the functions claimed in these claims, whereas the claims say that the first (gateway) processor does the functions. Thus, after the combination is made, it is necessary to further modify the combination using the present claims as a guide. This is not permitted under the patent law. MPEP §2142. See also *In re Vaack*, 20 USPQ2d 1438, 1432 (Fed. Cir. 1991), which the MPEP cites in support of this law. See also *W.L. Gore & Associates, Inc. v Garlock*, 220 U.S.P.Q. 303, 311-13 (Fed. Cir. 1983). Fourth, with respect to claim 24, Marwell et al. does not show debiting a transactional charge for an order being above a predetermined number, but rather discloses that for a predetermined charge an unlimited number of calls can be made.

In view of the above amendments and remarks, Applicants believe the pending application is in condition for allowance. Applicants believe no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 50-1848, under Order No. 010684.0103PTUS from which the undersigned is authorized to draw.

Respectfully submitted,  
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Dated: October 6, 2005

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